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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,401	08/08/2001	Jung-Wan Ko	1293.1059-D	3413

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EXAMINER

CHIEU, PO LIN

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 11/19/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,401

Applicant(s)

KO ET AL.

Examiner

Polin Chieu

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The examiner believes the that the present application has provisional obviousness type double patenting issues with all the applications presented in the IDS submitted on 4/3/02 (paper no. 3). However, for the sake of brevity the examiner will only present some of the double patenting issues related to the copending application 09/923,321.

2. Claims 8-10 and 12-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-7 and 9-10 of copending Application No. 09/932,321. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the copending application disclose an audio data area having audio data and linking information (lines 2-8); and a catalog information area other than the audio data area (lines 3-4) and during reproduction of the audio data, the linking information connects the corresponding catalog information to be reproduced with the audio data (line 2-11). Claim 9 of the copending application discloses common catalog information and title catalog information (lines 6-8).

Claim 1 of the copending application discloses an audio region in which the audio data is stored; and claim 4 of the copending application discloses an image information region in which the catalog information is stored.

Regarding claim 8, claim 5 of the copending application discloses an audio management region, audio title sets, catalog management region, and a catalog title set.

Regarding claim 9, claim 6 of the copending application discloses that the CTS comprises information on still pictures formed of a plurality of the title catalogs and sub-pictures relating to the audio data, and navigation information for controlling the information on the still pictures and the sub-pictures.

Regarding claim 10, claim 7 of the copending application discloses that the AMG region comprises the linking information to connect the audio data and the catalog information during playback.

Regarding claim 12, claim 9 of the copending application discloses an audio management region, audio title sets, catalog management region, and a catalog title set.

Regarding claim 13, claim 10 of the copending application discloses that the AMG region comprises the linking information to connect the audio data and the catalog information during playback.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claim 16 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 09/923,321. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the copending application

disclose an audio data area having audio data and catalog playback information (lines 2-8); and a catalog information area other than the audio data area and having catalog information related to the audio data during reproduction by the catalog playback information (line 3-11). Claim 9 of the copending application discloses common catalog information commonly applied for more than one of the audio data recorded on the storage medium (lines 6-8); title catalog information corresponding to each of the audio data (lines 6-8); a catalog management (CMG) region having management information on the catalog information (lines 9-11); and a catalog title set (CTS) in which at least one catalog title including the catalog information related to each item of the audio data is recorded (lines 12-15).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claim 17 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 09/923,321. Although the conflicting claims are not identical, they are not patentably distinct from each other because the audio data, catalog information, common catalog information, title catalog information, CMG, and CTS were disclosed by the claims of the copending application (see previous rejection). Further, claim 9 of the copending application discloses an audio management (AMG) region having management information of audio data (lines 3-4); and an audio title set (ATS) in which the audio data is recorded (line 5).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 7, 15, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kajiyama et al (6,283,764).

Regarding claim 1, Kajiyama et al discloses an audio area including audio and linking information (figs. 4 and 5); and a catalog area other than the audio area which includes catalog information related to the audio data (figs. 4 and 5); the catalog information comprising common catalog information commonly applied for more than one of the audio data recorded on the storage medium, and title catalog information corresponding to each of the audio data (fig. 5), and during reproduction of the audio data, the linking information connects the corresponding catalog information to be reproduce with the audio data (fig. 14, col. 5, line 37 – col. 7, line 26).

Regarding claim 7, Kajiyama et al discloses an audio region in which the audio data is stored; and an image information region in which the catalog information is stored (figs. 4 and 5).

Regarding claim 15, in contrast to the art rejection of claim 7, the entire disc other than the picture region can be interpreted to be an audio region storing the linking information and the catalog information (fig. 4); and an image information region (picture region, fig. 5) which contains no information (the disc can store any of the additional information shown in figure 5, but it does not have to).

Regarding claim 18, Kajiyama et al discloses an audio data area having audio data and linking data (figs. 4 and 5); another area other than the audio data area and which includes still picture information related to the audio data during reproduction according to the linking data (fig. 14); common still picture information commonly applied for more than one item of the audio data recorded on the storage medium (fig. 5, the still pictures could be the same picture); title still pictures corresponding uniquely to individual items of the audio data (fig. 14); a still picture management region having management information on the catalog information (col. 5, line 37- col. 7, line 26); and a still picture title set in which at least one still picture title including the still picture information related to each item of the audio data is recorded (figs. 4 and 5).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-6, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kajiyama et al in view of Heo (6,222,983).

Regarding claims 2 and 14, Kajiyama et al discloses that the storage medium includes an audio region storing audio data and an image information record region storing the catalog information. However, Kajiyama et al does not disclose that the catalog information is image information produced according to a DVD video specification; and the storage medium is a DVD.

Heo teaches storing image information according to the DVD video specification on a DVD (fig. 2). Since the catalog information is still picture and sub-picture data, it would have been obvious to store the catalog information as image information because picture and sub-picture data is stored as image information on DVDs.

It would have been highly desirable to store information on a DVD according to the DVD video specifications to that the data could be reproduce by a DVD player; and a DVD has a larger storage capacity than a CD-ROM.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to record according to the DVD video specification in the device of Kajiyama et al.

Regarding claim 3, Kajiyama et al discloses a still picture for a background image; a sub-picture for a caption; and navigation information for controlling the still picture and the sub-picture (figs. 5 and 14).

Regarding claim 4, Kajiyama et al discloses an audio data recording region in which audio data is recorded (figs. 4 and 5); and an audio information recording region for the entire audio data and/or audio data in units of distinct items of the audio data, in which is stored catalog playback information comprising the linking information connecting the audio data to the catalog information during playback (col. 5, line 37 – col. 7, line 26).

Regarding claim 5, Kajiyama et al does not explicitly disclose how the catalog and audio data are linked. It is well known in the art to provide the location of data to be reproduced. It would have been obvious to provide the location of the catalog information to be played back with the audio data. It would have been highly desirable to provided the location of the catalog information instead of another method of locating the catalog information so that the catalog information can be located quickly without having to perform any complicated processing. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have the location of the catalog information stored in the device of Kajiyama et al.

The limitations of claim 11 were discussed in the art rejection of claim 7. Please refer to the art rejection of claim 7.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Moriyama et al and Tashiro et al disclose karaoke devices; and Mimura et al discloses a DVD player.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Polin Chieu whose telephone number is (703) 308-6070. The examiner can normally be reached on M-Th 8:00 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew B. Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any response to this action should be mailed to:

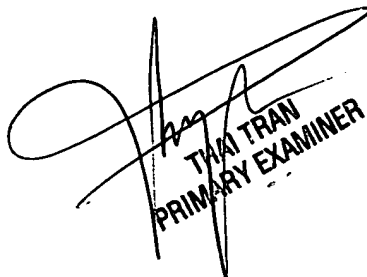
Commissioner of Patents and Trademarks

Washington, D.C. 20231

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

PC
November 14, 2003


THAI TRAN
PRIMARY EXAMINER